

Atty. Dkt. No.: P58317US2

Serial No.: 08/865,044

art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). When conducting an obviousness analysis, "all limitations of a claim must be considered in determining the claimed subject matter as is referred to in 35 U.S.C. 103 and it is error to ignore specific limitations distinguishing over the [prior art] reference." *Ex parte Murphy*, 217 USPQ 479, 481 (PO Bd. App. 1982). In the context of a rejection for obviousness under §103, the "*Examiner* bears [both] the initial burden . . . of presenting a *prima facie* case of unpatentability" and "the ultimate burden of persuasion on the issue." *In re Oetiker*, 24 USPQ 1443, 1444 and 1447 (Fed. Cir. 1992), *emphasis added*.

McCrea is the sole art relied on to reject the claims. The reference fails to teach or suggest, expressly or inherently, any of the limitations to

- "a container holding the composition,"
- "a flow valve extending into said container, and"
- "a means of propulsion"

(collectively referred to hereafter as "the spraying means") recited in present "device" claims 10-17 or the limitation to the method step of

- "spraying on the skin"

recited in present method claims 23-27. Since all the limitations in the present claims are not taught or suggested by the prior art relied on to reject the claims, the statement of rejection fails to establish a *prima facie* case of obviousness under §103(a). *Royka, supra*. The statement of rejection is in error

Atty. Dkt. No.: P58317US2  
Serial No.: 08/865,044

for ignoring that the aforesaid specific limitations distinguish over the reference relied on to reject the claims. *Murphy, supra*.

The statement of rejection ignores the fact that McCrae teaches nothing whatsoever about using the spraying means of present device claims 10-17. The statement of rejection relies on the allegation that the spraying means limitations of the present device claims were known in the art. According to the statement of rejection, the spraying means limitations amount to "a conventional delivery device, absent evidence to the contrary" (Office Action, page 3). Also according to the statement of rejection, McCrae allegedly teaches that "such topical compositions are routinely packaged as pump sprays (e.g., see column 1, lines 65-66 of McCrae et al.)" (Office Action page 3). More precisely, what McCrae, in fact, teaches with respect to a "pump spray" is:

U.S. Pat. Nos. 4,053,581; 4,065,564; and 4,073,880 disclose liquid anhydrous antiperspirant compositions useful as *pump-spray* and roll-on products, wherein the antiperspirant compounds are solubilized in a vehicle including *ethanol and a sufficient amount of volatile or a non-volatile silicone liquid* to reduce tackiness of the antiperspirant. [*Emphasis added.*]

(McCrae, column 1, lines 65, through column 2, line 3.) The aforesaid passages of McCrae teach that compositions other than the inventive McCrae composition can be used in a pump-spray. In fact, McCrae distinguishes its inventive composition from the compositions disclosed as useful in pump-sprays on the basis of McCrae's use of wax.

The stability of the anhydrous composition of the present invention, achieved with a *new and improved suspending agent including a finally-divided silica and a suspending wax composition*, is unexpectedly superior to each of the above-identified prior

Atty. Dkt. No.: P58317US2  
Serial No.: 08/865,044

*compositions* in regarding to synthesis, cosmetic field and degree of skin and clothing staining. [*Emphasis added.*]

(McCrea, column 3, lines 47-53).

However, whether or not the device limitations in the present claims are "conventional" is not the issue; the issue is obviousness of combining the recited "composition" with the recited spraying means in the manner presently claimed, and it is well established that conventionality does not equal obviousness. The fact that all elements of a claimed combination are conventionally known does not, by itself, make the combination obvious. *Ex parte Clapp*, 227 USPQ 972 (BPA&I 1985).

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

*In re Fritch*, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). An argument by the PTO is "not prior art." *In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). "It is facts which must support the legal conclusion of obviousness." *Ex parte Crissy*, 201 USPQ 689, 695 (POBdApp 1976).

The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not, because *it may doubt* that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis.

*In re Warner*, 154 USPQ 173, 178 (CCPA 1967) (*emphasis in original*).

[I]t is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention.

*Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988).

Atty. Dkt. No.: P58317US2  
Serial No.: 08/865,044

It is insufficient that the prior art disclosed the components of the patented device, either separately or used in other combinations; there must be some teaching, suggestion, or incentive to make the combination made by the inventor.

*Northern Telecom, Inc. v. Datapoint Corporation*, 15 USPQ2d 1321, 1323 (Fed. Cir. 1990), *cert. denied*, 498 U.S. 920 (1990).

As for the "spraying" step of present method claims 23-27, the statement of rejection alleges that spraying the topical composition onto the skin is an "inherent" feature in McCrea. However, reliance on such a teaching as being inherent in McCrea is misplaced, because it is *not* inherent in the reference.

In order for the Examiner to rely on the theory of inherency (i.e., that a limitation in the claims is inherently disclosed in the reference) the limitations at issue can be the only possible outcome of the teachings of the reference; that is, the allegedly inherent limitations must be "inevitable" from the teachings of the reference. *In re Wilding*, 190 USPQ 59, 62 (CCPA 1976) (*emphasis added*). "In relying on a theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ 2d 1461, 1464 (BPAI 1990) (*emphasis in original*). Before "the burden shifts," the examiner has "the initial burden of establishing a *prima facie* basis for the alleged inherency." 17 USPQ2d at 1463-64. An argument by the PTO is "not prior art." *Rijckaert*, 28 USPQ2d at 1957. When the

PTO asserts that there is an explicit or *implicit* teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears *in the reference*. ... The mere fact that a certain thing *may*

Atty. Dkt. No.: P58317US2  
Serial No.: 08/865,044

result from a given set of circumstances is not sufficient to establish inherency.

28 USPQ2d at 1957 (*emphasis added*). A "retrospective view of inherency is not a substitute for some teaching or suggestion which supports the selection and use of the various elements in the particular claimed combination." *In re Newell*, 13 USPQ 2d 1248, 1250 (Fed. Cir. 1989).

In the present case, the statement of rejection has failed to demonstrate that "spraying" on to skin is an inevitable feature of McCrae. The statement of rejection has not even satisfied its burden to "indicate where such a teaching or suggestion appears in the reference." *Rijckaert, supra*. Accordingly, the rejection for obviousness fails for relying on an allegedly inherent teaching in McCrae, without having carried its burden of demonstrating the teaching is, in fact, inherent. *Wilding, supra*.

Moreover, as mentioned above, the rejection fails because the use of "consisting essentially of" excludes the composition of McCrae from the scope of the present claims.

As previously explained by Applicants, the use of the "suspending wax composition," in particularly, the "wax" contain therein, would materially affect the basic and novel characteristics of "dispensing a composition onto the skin in the form of aerosol particles" by the presently claimed "device" invention. More precisely, McCrae requires the presence of a "hard" wax (having a melting point of above 150°F), such as castor wax, beeswax, and caruaba wax, (McCrae, column 12, lines 30-42). The particular wax used must be able to be "incorporated into the paste-like suspending wax composition" (McCrae, column 13, lines 9-12). Such a suspending wax composition would adversely affect the ability of the presently claimed device to operate in the manner claimed, i.e., a

Atty. Dkt. No.: P58317US2

Serial No.: 08/865,044

“device suitable for dispensing a composition onto the skin in the form of aerosol particles,” in which device “the composition consists essentially of” the recited ingredients, which form aerosol particles when sprayed from the claim device. Assuming, arguendo, that it might be possible to spray the waxy paste composition of McCrea, this would not change the exclusionary effect of “consisting essentially of”; as long as the waxy paste composition adversely affects the basic novel and characteristics of the presently claimed invention, it is excluded by “consisting of,” in other words, the adverse effect need not be total in capacity.

According to the statement of rejection, use of “consisting essentially of” does not exclude from the present claims the composition taught in McCrea because, allegedly, Applicant “has the burden of showing that the basic and novel characteristics of its composition would be materially changed if the unspecified ingredients not claimed were added (Office Action, page 4). The statement of rejection relies on *In re De Lajarte*, 143 USPQ 256 (CCPA 1964), to support the allegation that would place the burden on Applicants to prove the adverse effect resulting from using the composition disclosed in McCrea. Reliance on the *de Lajarte* decision is totally misplaced, since the decision stands for the exact opposite of the position taking in the statement of rejection, that is, *De Lajarte* held that a patent applicant does *not* have such a burden.

Misplaced reliance by the statement of rejection is readily demonstrated in the following excerpts from *De Lajarte* (143 USPQ 258 and 259), where the court took up the issue of whether “sulfur and carbon . . . are excluded from appellee’s composition by the words ‘consisting essentially of’:

Atty. Dkt. No.: P58317US2  
Serial No.: 08/865,044

Appellant and the Solicitor agree that the issue is whether the introduction of sulfur and carbon would materially change the characteristics of Appellant's insulating glass. The Solicitor would put the burden of showing a material change on the Appellant.

*De Lajarte*, 143 USPQ at 258. The court rejected the contention of the Solicitor, holding

*we can find no justification for placing the burden on Applicant to conduct experiments to determine the insulating properties of the colored glass disclosed by Lyle. Although there are only very slight differences between the Lyle composition and that sought to be patented, we cannot assume that these small differences are incapable of causing a difference in properties.*

*De Lajarte*, 143 USPQ at 259. The aforesaid quoted text from *De Lajarte* unequivocally rejects the proposition that a patent applicant has the burden of demonstrating that unrecited elements would adversely affect the claimed invention in order for the unrecited ingredients to be excluded from the claims by the transitional phrase "consisting essentially of." Whereas, the statement of rejection assumes that the different materials disclosed in McCrea would not cause a difference in properties, the *De Lajarte* decision, on the contrary, requires that the Examiner "*cannot assume that these . . . differences are incapable of causing a difference in properties*" 143 USPQ at 259 (*emphasis added*).

Moreover, as in *De Lajarte*, in the present situation there is "total absence of evidence in the record to indicate that" the composition disclosed by McCrea would be expected to have desirable aerosol spraying properties. 142 USPQ 259. In the present case, McCrea provides no teaching or suggestion, whatsoever, that the suspending-wax-based composition would have such properties as possessed by the presently claimed invention.